



REMARKS

Claims 1-7 and 11-15 are now pending in the application. Claims 11-15 are newly added, by Applicant's representative, to more clearly point out and distinctly claim that which Applicant regards as his invention. In the Office Action dated March 6, 2002 and related to U.S. Patent Application No. 09/499,069 ("Prior Application"), the Examiner finally rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Skelton, U.S. Patent No. 4,850,611 ("Skelton") in view of Cowan, U.S. Patent No. 3,734,396 ("Cowan") and further in view of Jacobs, et al., U.S. Patent No. 4,488,737 ("Jacobs"). The Examiner additionally rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and further in view of Zoland, U.S. Patent No. 5,303,956 ("Zoland").

The current claims have been extensively discussed in three Office Actions and three Office Action Responses related to the Prior Application. Applicant's representative's remarks concerning those discussions, and the current state of the claims, are provided below in three subsections. First, Applicant's representative provides evidence, related to the *Graham* and other secondary considerations, that Applicant's claimed invention is nonobviousness. Second, Applicant's representative discusses the Examiners arguments included in the most recent Office Action. Finally, Applicant's representative summarizes Applicant's representative's many traversals of the Examiners obviousness-type rejections. Applicant's representative continues to believe that all current claims are allowable, and respectfully traverses the Examiner's obviousness-type rejections related to the Prior Application.

Applicant's Claimed Invention Is Not Obvious

In Applicant's representative's opinion, Applicant's claimed invention is clearly not obvious in light of any single reference, or combination of references, so far cited by the Examiner with regard to the Prior Application. In the first Office Action Response filed by Applicant's representative, on February 12, 2001, Applicant's representative noted that:

[i]n MPEP § 2141, a standard of patentability that arose in the Supreme Court case *Graham v. John Deere*, 283 U.S. 1, 148 USPQ 459 (1966) is provided in

detail. This *Graham* standard includes secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc. While the current application is directed toward a relatively simple and straightforward invention, there are a number of such secondary considerations that would argue strongly against an obviousness-type rejection. First, the Applicant has, in the year following filing of the application, built a significant business manufacturing and selling the single-sheet registration form and key packet that is the subject of the current application. The Applicant is selling the single-sheet registration form and key packets to major hotel chains, including Hilton Hotels, which have recognized efficiencies and economies in using Applicant's invention during registration of hotel guests. No such single-sheet registration form and key packet was available prior to Applicant's entry into this field, and Applicant's clients have responded to Applicant's product enthusiastically. Second, Applicant has received notice from several print shops that the print shops have been contacted by third parties to produce single-sheet registration form and key packets as disclosed in the current application, but without the patent pending status included by Applicant on his products. While perhaps a simple invention, Applicant's invention is nevertheless important to Applicant, is extremely well regarded in the hotel industry, and is already a target for copying by Applicant's competitors.

The Examiner has not yet responded to these noted facts, which Applicant's representative believes are strong evidence of the nonobviousness of Applicant's claimed invention. Applicant's representative therefore has provided, in the Current Response, a signed Affidavit, accompanied by four Exhibits, from the Applicant stating: (1) that Applicant has achieved ever-increasing retail sales volume for single-sheet registration forms and key packets, as claimed by Applicant; (2) that Applicant's single-sheet registration forms and key packets have been copied and advertised for sale by competitors; (3) that a subsidiary of one of Applicant's customers has attempted to force Applicant to remove the "Patent Pending" notice from Applicant's products, to enable the subsidiary to offer Applicant's competitors a chance to bid on producing products that would infringe Applicant's claimed invention; and (4) that Applicant invented the single-sheet registration forms and key packets as a result of the convergence of careful observations of prior systems and techniques, experience in electronic forms production, the advent of commercially viable laser printers, and a significant development and experimentation effort.

As noted in the MPEP § 2144.08 (II)(B), "Office Personnel should consider all rebuttal arguments and evidence presented by applicants. ... Rebuttal evidence may include

evidence of 'secondary considerations,' such as 'commercial success, long felt but unsolved needs, [and] failure of others.' ... Rebuttal evidence may include evidence that the claimed invention was copied by others." Applicant's representative respectfully requests the Examiner to enter the supplied Affidavit and evidence into the record, and to consider the supplied evidence with regard to the Examiner's obviousness-type rejections.

Rejections of Claims in the Prior Application Were Improper

Applicant's representative respectfully believes that the Examiner's rejections, and accompanying arguments, in the most recent Office Action related to the Prior Application are improper. For example, on page 6 of that Office Action, the Examiner states: "Applicant argues that Skelton's unfolded form is not rectangular and could not be fed through a laser printer. The Examiner disagrees. As seen in Figure 1, Skelton fully discloses a number of rectangular panels that are joined by perforations providing a substantially rectangular form. A protruding flap (43) located adjacent to one of the panels would not inhibit the form from being fed through a laser printer." As noted in *In re Brown*, 459 F.2d 531,535, 173 USPQ 685, 688 (CCPA 1972), "[a]s a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." From Applicant's representative's experience, rectangular paper having even small departures in dimensions from standard paper sizes can cause laser printers to malfunction, let alone a relatively large protruding flap. Nowhere in Skelton are the dimensions of Skelton's foldable container disclosed. Even were Skelton's unfolded foldable container actually rectangular, which it is not, there can be no certainty that it would be able to be fed through a laser printer without frequent jamming, or at least infrequent jamming at levels unacceptable in commercial environments. But, with a flap of relatively large area protruding from the bottom of the foldable container, it is quite probable that the foldable container could not be used in laser-printer-based applications. The Examiner argues, on page 3 of the Office Action, that the rejection is based on an embodiment of the Skelton foldable container including only 3 panels. Inspection of Figure 1 of Skelton clearly demonstrates that, as depicted, the protruding panel (43) would, in a three-panel embodiment, constitute fully 13% of the area of the three-panels, and

would represent an excursion of fully 37% in the width of the rectangle formed by the three panels. To refer to the proposed 3-panel-and-protruding-flap embodiment of Skelton's foldable container as "substantially rectangular" is simply inconsistent with the well-established meaning of the term "substantially rectangular" and misleading. To assume that such irregular-shaped forms could be fed through a laser printer, in a commercial application, is improper, especially without disclosed dimensions of the foldable container, and in view of the relatively large, protruding flap.

Beginning with the final paragraph on page 6 of the Office Action, the Examiner, responding to Applicant's representative's previous traversals, pointing out that the Examiner has failed to provide a teaching, motivation, or suggestion for combining the cited references, states that "Skelton, as modified by Cowan, Jacobs, and Zoland, fully discloses the claimed invention of a rectangular, single-sheet registration form and key packet as presently claimed and as set forth in the above rejections." Again, Applicant's representative respectfully believes that this response is improper, and evidences a misunderstanding of the requirements of an obviousness-type rejection based on a combination of references. First, as pointed out by Applicant's representative in previous Office Action Responses, Skelton discloses a single-sheet ticket envelope form that is not rectangular and that therefore, by itself, does not disclose even one of Applicant's claimed elements. Cowan discloses a ticket envelope that requires application of an adhesive during the manufacturing process, and that cannot be "quickly and accurately folded into a complete key packet in two or fewer steps." Jacobs discloses a combined key holder and booklet that requires assembly operations in addition to simple folding operations, and that is manufactured from multiple sheets. No combination of these disclosures results in Applicant's rectangular single-sheet registration form and key packet. Not one of the cited references discloses or suggests a single-sheet, rectangular form, and none of the references discloses or suggests a single-sheet, rectangular form designed to be printed in a laser printer. Instead, the Examiner appears to be saying that, if the Examiner were to take various features of the cited references and significantly modify those features so that they could be incorporated into a single-sheet registration form and key packet, then the Examiner could produce a single-sheet registration form and key packet. Indeed, if looked at with the advantage of hindsight, almost

any patentable invention may be produced by extracting, modifying, and combining previously existing elements. The courts have long recognized this, and have repeatedly warned against obviousness-type rejections based on hindsight recognition. For example, the MPEP § 2143.01 states that "[t]he mere fact the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Furthermore, in the same section, the MPEP indicates that a proposed modification cannot render the prior art unsatisfactory for its intended purpose of change its principle of operation. Skelton discloses neither a rectangular nor a substantially rectangular foldable form, as discussed above. Removing the flap from Skelton would remove the very feature that differentiates Skeltons foldable container from a folded piece of paper, namely the "flap 43 secured by weakened zone 45 [that] prevents the tickets from falling out of the container or envelope." (Skelton, column 7, lines 4-6).

Summary of Previously Presented Traversals

One embodiment of Applicant's invention is a rectangular, single-sheet combined registration form and key packet that may be printed during registration of a hotel guest. The combined registration form and key packet may be printed on a laser printer by a hotel clerk after entering hotel guest information into a computerized registration system. The hotel clerk may then detach the registration form from the combined registration form and key packet. The registration form is signed by the hotel guest and returned to the hotel clerk, while the hotel clerk folds the key packet along perforated lines and inserts a hotel room key into the completed key packet. Finally, the hotel clerk provides the folded key packet including the hotel room key to the hotel guest.

Figure 2 illustrates a rectangular, single-sheet, combined registration form and key packet blank. The blank includes a vertical line of perforations (202 in Figure 2) and two horizontal lines of perforations (204 and 210 in Figure 2). In addition, the blank includes, as illustrated in Figure 2, two die-cut slots (214 and 212 in Figure 2) for holding a metal key and a rectangular magnetic key card, respectively.

Independent claim 1 is directed to the single-sheet, combined registration form and key packet illustrated in Figure 2.

Claim 1 recites:

1. A rectangular, single-sheet registration form and key packet comprising:
 - a registration form;
 - an unfolded key packet separated the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and
 - one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

Thus, Applicant's rectangular, single-sheet registration form and key packet includes: (1) a registration form; (2) an unfolded key packet separated from the registration form by a line of perforations; and (3) one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys.

Skelton discloses a single-sheet ticket envelope. Skelton does not, however, include die-cut slots, a detachable registration form, or a registration form and key packet. Moreover, Skelton discloses complex embodiments that require numerous folding operations. For example, the embodiment shown in Figure 1 would require nine folding operations in order to assemble the complete ticket envelope. Finally, Skelton's unfolded form is not rectangular, having a protruding flap (43 in Figure 1), and could not therefore be fed through a laser printer. Thus, by itself, Skelton does not disclose even one of Applicant's claimed elements.

Cowan is also a ticket envelope. However, Cowan's ticket envelope requires application of an adhesive during the manufacturing process: "Of course with such an arrangement, adhesive 42 would be applied to the outer face of flap 20" (Cowan, column 2, lines 50-52). Thus, Cowan's ticket envelope cannot be "quickly and accurately folded into a complete key packet in two or fewer steps." Moreover, Cowan employs fold lines rather than lines of perforations to facilitate assembly of the ticket envelope, and includes more than two fold lines (34, 40, and 44 in Figure 3). Finally, like Skelton's ticket envelope, Cowan's unfolded

ticket envelope is not rectangular, but includes several asymmetrical flaps (16, 20, and 22 in Figure 2) that would prevent feeding of the unfolded ticket envelope through a laser printer.

Jacobs discloses a combined key holder and booklet. Like Cowan, Jacobs' key holder and booklet requires assembly operations in addition to simple folding operations. Moreover, Jacobs is not a single-sheet form, but is instead manufactured from multiple sheets (e.g. Figure 7). Jacobs does include a slit (40 in Figure 4) for holding a key, but does not characterize that slit as being "die-cut."

Thus, Cowan discloses a detachable flap, Jacobs discloses a slit for holding a key, and Cowan, Jacobs, and Skelton all disclose various assembled envelopes. However, neither Cowan, Jacobs, nor Skelton disclose a rectangular, single-sheet registration form and key packet with "at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or three steps." Thus, no possible combination of Cowan, Jacobs, or Skelton produces the elements claimed by Applicant in claim 1. Because the remaining claims in the current application depend from claim 1, Applicant's representative believes that they also are not made obvious by a combination of Cowan, Jacobs, and Skelton.

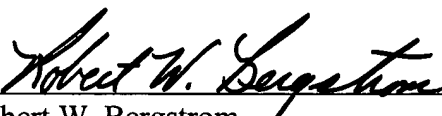
Summary

Applicant's representative believes that the current claims are clearly allowable. During the course of prosecution of the Prior Application, the Examiner has repeatedly offered essentially the same references to support various obviousness-type rejections. As repeatedly pointed out by Applicant's representative, the combination of these references does not produce Applicant's claimed single-sheet registration form and key packet without modification based on hindsight recognition. Applicant's affidavit, supplied as an attachment to this response, clearly indicates that Applicant has achieved significant commercial success, that Applicant's claimed invention has been copied by others, that at least one of Applicant's customers has attempted to force Applicant to remove his "Patent Pending" notice from Applicant's product, and that Applicant produced his invention as a result of a rational inventive process followed by extensive development and experimentation over a long period of time. The fact that no product within the

scope of the current claims was produced or disclosed during this lengthy period of time, from Applicant's determination of the need for such a product in the late 1980's and early 1990's, until Applicant developed the product and commercialized it, the fact that Applicant has achieved a large and ever-increasing retail sales volume from the product, the fact that the product has gained widespread acceptance in the marketplace, and the fact that, since successful commercialization, Applicant's competitors have attempted to sell products that would infringe Applicant's claims, all suggest that Applicant's claimed invention was nonobvious at the time Applicant first filed his provisional patent, in 1999.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
Ted Eugene Wright
HENDRICKS & LEWIS



Robert W. Bergstrom
Registration No. 39,906

Version With Markings to Show Changes Made

In the Specification

After the title, please add the following new section:

CROSS REFERENCE TO RELATED APPLICATION

This application claims benefit of Provisional Patent Application No. 60/135,136, filed May 20, 1999.

In the Claims

New claims 11-15 have been added